

REMARKS

Applicant hereby further responds to the Final Action of September 18, 2006, and the Advisory Action of January 23, 2007, in the above-referenced patent application by filing this preliminary amendment along with a Request for Continued Examination (RCE). Claims 1-33 are pending in the application.

Claims 1-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,738,978 to Hendricks et al ("Hendricks") in view of USPN 6,898,762 to Ellis et al ("Ellis"). Claims 1, 5, 11, 15 and 18 have been amended to further clarify the claimed limitations in view of the comments by the Examiner in the Advisory Action of January 23, 2007. Rejection of Claims 1-25 is respectfully traversed because, for at least the following reasons, the references, alone or in combination, do not disclose all of the claimed limitations as amended.

In the Final Action of September 18, 2006, the Examiner withdrew claims 26-33 from consideration since the Examiner believed claims 26-33 required additional searching. Applicant traversed, and respectfully maintains traversal of the restriction requirement. Further, since this preliminary amendment is filed with an RCE, claims 26-33 are respectfully provided again for examination, and for which the Examiner can search as needed. Claims 26-29 have been amended to further clarify the claimed limitations. Claim 26 is now an independent claim and includes limitations of existing claims 1 and 2. Similarly, claim 27 is now an independent claim and includes limitations of existing claims 1 and 2. Claims 28 and 29 are now dependent on claim 27.

Claim rejections under 35 U.S.C. 103(a)

As per **Claim 1**, the references do not disclose the claimed limitations.

A. Hendricks does not disclose digital signal having information reflective of at least one regular program and at least one Background Commercial as claimed. Background Commercials according to the present invention differ from typical commercial advertisements in Hendricks. A typical commercial advertisement is shown between or in the middle of regular non-commercial programs. Hendricks, col. 38, lines 32-46, describes that during viewing a regular television program, the system switches the user to another channel to show the user commercial advertisements. The regular television program is interrupted for the commercial advertisements.

However, as claimed herein, Background Commercials are available for selective viewing during a regular program. Therefore, as claimed, regular programming need not be interrupted to view Background Commercials. By contrast, in Hendricks, regular programming is required to be interrupted to view commercials/advertisements/movie purchase, etc. Further, in Fig. 36a, Figs. 30b-g, 31, 32a-b (relied on by the Examiner) Hendricks shows service/program menus, which are not Background Commercials as claimed.

B. Hendricks does not disclose selection means for allowing the end user to select, for display on the presentation unit, between: the at least one regular program, the

at least one Background Commercial, and the at least one regular program with the at least one Background Commercial, as required by Claim 1. In Hendricks, the user cannot select the commercial advertisements that are shown to the user. The commercial advertisements are selected by the system (controller 214) based on the information gathered on the type of regular television program a user watches, and the system selected commercial advertisements are then sent to the set top terminal 220 (col. 18, lines 34-40; col. 32, lines 48-55 and 62-65; col. 33, lines 51-58; col. 36, lines 61-64; col. 37, lines 11-27). The system then interrupts the regular programming, and based on the type of regular programming being watched, switches the user to a channel to show her the system selected commercial advertisements, without selection by a user (col. 38, lines 32-46).

In Fig. 3 (relied on by the Examiner) a remote control does not allow the user to select between a regular program and a Background Commercial for display on the presentation unit. The remote control 900 only allows the user to access regular programming (col. 14, lines 27-30), but not select between a regular program and a Background Commercial for display on the presentation unit, as claimed. Further, in col. 16, lines 16-61 (relied on by the Examiner), there is no disclosure of a selection means, or ability of a user to select between a regular program and a Background Commercial for display on the presentation unit, as claimed. In Hendricks, commercial selection and display is done by the system (col. 12, lines 19-24). Hendricks does not provide any ability for the user to select between programs or commercials that the controller 214 selects and sends to the set top terminal 220.

C. Further, unlike Hendricks, the return channel in the claimed invention is configured to communicate Commercial Viewing Data from the receiver to a digital service operator. In Hendricks the set top terminal 220 does not communicate commercial viewing data to the controller 214. Rather, in Hendricks regular television programming viewing data is sent back to the controller 214 by the terminal 220. This is further made clear by the fact that in Hendricks, as discussed above, the user cannot select the commercials that are shown to the user (the system selects the commercials). As such, there is no commercial viewing data gathered by the set top terminal 220 to be sent back to the controller 214 since the user cannot select commercials. In Hendricks regular television programming viewing data is sent back to the controller 214 by the terminal 220.

D. The Examiner has interpreted commercial channels such as shopping channels, air line reservation, etc. in Hendricks as background commercial channels that the user can select. This interpretation of Hendricks is respectfully traversed. The commercial channels in Hendricks are not background commercial advertisements as claimed herein. In Hendricks, the user selects the commercial channels to actively interact business, whereas commercial advertisements are promotional materials put together by advertisers (col. 35 line 65 to col. 39, line 8) and shown to the user by the system by interrupting a television program (as discussed above). The commercial advertisements are to entice the user to buy certain goods/services (e.g., advertisement entices the user to select a commercial channel to buy the advertised goods/services). As

such, the Examiner's interpretation of commercial channels in Hendricks as commercial advertisements goes against explicit teachings of Hendricks itself.

E. Further, as the Examiner also states, Hendricks does not disclose displaying at least one regular program with at least one background commercial. This further corroborates Applicant's arguments above that Hendricks does not disclose the claimed selection means. However, the Examiner interprets Ellis to disclose displaying at least one regular program with at least one background commercial, and then modifies Hendricks according to Ellis to reject Claim 1. Applicant respectfully traverses this interpretation of Ellis, and further submits that the references, alone or in combination, do not disclose all of the claimed limitations.

Figs. 18 and 20a of Ellis, along with col. 17, lines 37-53; col. 19, line 64 to col. 20, line 16, and col. 20, lines 43-58 (relied on by the Examiner) simply discuss showing a program guide on a TV screen over video for a current channel. The program guide in Ellis is not a Background Commercial. Ellis too has to interrupt regular programming to show commercials, regardless of how the program guide is displayed.

F. Ellis does not disclose selection means for allowing the end user to select, for display on the presentation unit, between: the at least one regular program, the at least one Background Commercial, and the at least one regular program with the at least one Background Commercial. Therefore, unlike the program guide of Ellis, unless the user selects to see the Background Commercials, then the user will not be bothered by

any Background Commercials while watching regular programs. The reminder list in Fig. 18 of Ellis is not a Background Commercial, rather part of the program guide. Further, in Ellis changes to expressions for program guide in Ellis has nothing to do with selection means for allowing the end user to select, for display on the presentation unit, between: the at least one regular program, the at least one Background Commercial, and the at least one regular program with the at least one Background Commercial, as claimed.

G. Further, there is no justification or advantage in modifying Hendricks according to Ellis. It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination, "...invention cannot be found obvious unless there was some explicit teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound." *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added).

Neither of the references suggests the motivation to modify or combine the references as proposed. The references are individually complete and functionally independent for their limited specific purposes and there would be no reason to make the modification proposed by the Examiner. Because neither of the prior art references

suggests the combination and modifications proposed by the Examiner the combination and modifications are improper.

There is no advantage in modifying Hendricks according to Ellis to show program guide overlays of Ellis, as the Examiner suggests. Even if Hendricks is modified with Ellis as the Examiner suggests to show program menu overlays on regular programs, the commercials in Hendricks would still interrupt regular programming to be viewed. Hendricks, col. 38, lines 32-46, describes that during viewing a regular television program, the system switches the user to another channel to show the user commercial advertisements. The regular television program is interrupted for the commercial advertisements. This is shown in Fig. 36a, Figs. 30b-g, 31, 32a-b, relied on by the Examiner. For at least these reasons, it is respectfully submitted that rejection of Claim 1 should be withdrawn.

As per **Claim 2**, it is respectfully submitted that Hendricks does not disclose that the information reflective of the at least one Background Commercial contains Audio-Visual Information and/or Banner Information, the Banner Information being presented to the presentation unit with the at least one regular program. Figs. 30c-30g in Hendricks (relied on by the Examiner) do not disclose commercial banner information that is displayed with a regular program as claimed herein. The only reference to a banner in Hendricks (col. 47, lines 31-33) is in relation to Fig. 31 in conjunction with a menu, not in conjunction with a regular television program that is in progress, as claimed herein.

The banner in Hendricks shows date and time, not advertisements. The banner in Hendricks has no commercials, and is not shown along with a regular television program.

There is no disclosure in Hendricks that: “information reflective of the at least one Background Commercial contains Audio-Visual Information and/or Banner Information,” as claimed herein. There is no disclosure in Hendricks of: “the Banner Information being presented to the presentation unit with the at least one regular program,” as claimed herein.

As per **Claim 3**, Hendricks does not disclose a control switch whereby the user can filter the Background Commercial portion of the digital signal from being delivered to the presentation unit, as claimed. As discussed in relation to Claim 1, in Hendricks the system (i.e., controller 214) selects advertisements or background commercials, not the user. Further, the user cannot filter background commercials selected by the controller 214. In col. 16, lines 16-61 (relied on by the Examiner), there is no disclosure that a user can filter advertisements as claimed. In Hendricks, commercial selection and display is done by the system (i.e., controller 214 and set top terminal 220, without ability of the user to filter commercials). Hendricks does not provide any ability for the user to select or filter commercials that the controller 214 selects and sends to the terminal 220. If the Examiner believes otherwise, Applicants respectfully request that the Examiner provide specific reference to language and software/hardware in Hendricks that receives filtering commands from the user, and allows commercial filtering by the user.

As per **Claim 4**, Hendricks does not disclose means for communicating the Background Commercial Viewing Data over the return channel from the receiver to the service operator, as claimed. The return channel in the claimed invention is configured to communicate Commercial Viewing Data from the receiver to a digital service operator. As discussed above, in Hendricks information about user viewing of regular programming is sent back from the set top terminal 220 to the controller 214. There is no Background Commercial Viewing data in Hendricks to send back to the controller 214. Further, Hendricks does not disclose means for updating a Background Commercial Viewing Record with the Background Commercial Viewing Data communicated from the receiver to the digital service operator, as claimed.

As per **Claims 5-10**, Applicant respectfully objects to the omnibus rejection of these claims without specific reasoning for rejection of each claim. Nevertheless, Applicant hereby attempts to respond to these rejections as best understood by Applicant. The Examiner has rejected Claims 5-10 for essentially the same reasons as rejection of Claims 1-4 and further in view of Fig. 12 with viewer log file, and col. 31, line 18 to col. 32, line 65 in Hendricks.

Rejection of Claims 5-10 is respectfully traversed for at least the reasons provided in relation to Claims 1-4 above. Further, Hendricks states that the viewer log file in Fig. 12 contains viewer information which as the Examiner admits the system in Hendricks uses to select and target advertisements to viewers (i.e., viewers do not select/filter advertisements). As discussed above, no Background Commercial Viewing Data is

generated in Hendricks or sent to the controller 214. Nor is there a file or database in Hendricks which stores Background Commercial Viewing Data as such data does not exist and is not gathered in Hendricks. As detailed above, user viewing habits of watching regular programs are gathered by the monitor 220 and sent to the controller 214 which is used to target advertisements to the users. Further, as per claim 5, for at least the reasons discussed above in relation to claim 1, Hendricks and Ellis, alone or in combination do not disclose a receiver for receiving the digital signal and a presentation unit for displaying at least a portion of the digital signal, the Banner Information being presented to the presentation unit with the at least one regular program, as required by Claim 5.

Claim 11 was rejected for essentially the same reasons as rejection of Claim 1, and as such should be allowed for at least the reasons provided above in relation to Claim 1. Further, as discussed in relation to Claim 2, Hendricks does not disclose a combined digital television signal which combines information reflective of regular programming and Background Commercials, the information reflective of the Background Commercials containing Audio-Visual Information and/or Banner Information, as claimed herein. Further, Hendricks does not disclose the steps of, in the receiver selecting a selected portion of the combined digital signal from the information reflective of the regular programming and the Background Commercials for display at a presentation unit, as claimed herein.

Further, Hendricks does not disclose creating a combined digital television signal which combines information reflective of regular programming and Background Commercials. Hendricks does not even disclose a digital signal that includes Background Commercials. Nor does Hendricks disclose that the information reflective of the Background Commercials containing Audio-Visual Information and/or Banner Information, as claimed. Further, Hendricks does not disclose selecting a portion of the combined digital signal from the information reflective of the regular programming and the Background Commercials for display at a presentation unit, as claimed. Further, as per claim 11, for at least the reasons discussed above in relation to claims 1 and 5, Hendricks and Ellis, alone or in combination do not disclose selecting a portion of the combined digital signal from the information reflective of the regular programming and the Background Commercials for display at a presentation unit; and displaying the selected portion of the combined digital signal on the presentation unit, as required by Claim 11.

Claims 12-14 were rejected for the same reasons as rejection of Claims 2-4, and should be allowed for at least the reasons provided above in relation to Claim 1 and Claims 2-4. Further as to Claim 13, Hendricks does not disclose the steps of determining an economic benefit based upon the updated Background Commercial Viewing Record. Nor does Hendricks disclose providing that economic benefit to the end user.

Claim 15 was rejected for essentially the same reasons as rejection of Claim 1 and the additional interpretation by the Examiner that: in Fig. 3 the user uses a remote

interface for controlling the TV and cable box or set top terminal 220 -- a receiver in receiving digital stream signals and decoding digital signals (Fig. 24c and col. 12, line 35 to col. 14, line 40 for the set top terminal and the remote control device).

Rejection of Claim 15 is respectfully traversed for at least the reasons provided above in relation to rejection of Claim 1. Further, as discussed in relation to Claim 2, Hendricks does not disclose a digital signal having information reflective of a regular program and at least one Background Commercial, wherein the information reflective of the at least one Background Commercial contains Banner Information, as claimed herein.

In Fig. 3 (relied on by the Examiner) the remote 900 does not provide a mechanism for selection between a regular program and a Background Commercial for display on the presentation unit. Fig. 24c in Hendricks is a schematic of the set top terminal 220, and col. 12, line 35 to col. 14, line 40 in Hendricks (relied on by the Examiner) provides a description of the set top terminal 220 and the remote control device 900. In these passages Hendricks does not disclose means for receiving the signal reflective of the at least one Background Commercial and providing a signal reflective of the Banner Information. Hendricks does not disclose any Banner Information related to commercial information as claimed herein.

Clearly, there is no disclosure in Hendricks of the steps of a means for providing a video output signal that combines information from the signal reflective of the regular program and the signal reflective of the Banner Information. As noted, no Banner

Information of the type claimed herein is disclosed by Hendricks. The Examiner refers to the lengthy passage in col. 12, line 35 to col. 14, line 40 in Hendricks, without specifics which disclose the claimed limitations. That passage says nothing more than what has already been addressed herein as far as the claimed limitations are concerned. If the claims are once again rejected, Applicant respectfully requests that the Examiner point to specific language in Hendricks that discloses the claimed limitations. Further, as per claim 15, for at least the reasons discussed above in relation to claims 1 and 5, Hendricks and Ellis, alone or in combination do not disclose for providing a video output signal, the means for providing the video output signal combining information from the signal reflective of the regular program and the signal reflective of the Banner Information, as required by Claim 15.

Claims 16-17 and 18-25, were rejected for essentially the same reasons as rejection of Claims 1-15, and are therefore allowable for at least the reasons provided in relation to Claims 1-15. Further, the Examiner has provided general conclusions in rejecting the claims without specific references to Hendricks or Ellis. It is respectfully submitted that the Examiner's conclusions are not supported by Hendricks and Ellis for at least the following reasons.

As per **Claim 16**, Hendricks and/or Ellis does not disclose: "a User Interface means for obtaining User commands to enable or disable the inclusion of Banner Information in the video output signal and a control unit for providing control signals reflective of the User commands." As discussed above, in Hendricks and/or Ellis there is

no commercial Banner Information as claimed herein and further the user cannot enable or disable inclusion of commercials, as claimed herein. It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or where such limitations are disclosed.

Further, as per **Claim 17**, there is no mechanism in Hendricks and/or Ellis to gather or store Background Commercial viewing data, as claimed. There is no mechanism in Hendricks to provide a signal reflective of selected Background Commercial viewing data, as claimed herein. It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further as per **Claim 18**, Hendricks and/or Ellis does not disclose that information reflective of the at least one Background Commercial contains Audio-Visual Information and Banner Information, as claimed herein. Further, Hendricks does not disclose: “means for receiving the second signal reflective of the at least one Background Commercial and providing *a first BC signal* reflective of the Banner Information related to one of the at least one Background Commercials and *a second BC signal* reflective of Audio-Visual Information related to the one of the at least one Background Commercials,” as required by Claim 18 (emphasis added). Nor does Hendricks and/or Ellis disclose: “means for providing a video output signal, the means for providing the video output signal combining information from one of (i) the signal reflective of the regular program or (ii) the second BC signal, with information from the signal reflective

of the Banner Information,” as required by Claim 18. It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per **Claim 19**, Hendricks and/or Ellis do not disclose that: “the means for receiving the signal reflective of the at least one Background Commercial provides a *third BC signal* reflective of information identifying the one of the at least one Background Commercials,” as required by Claim 19 (emphasis added). It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per **Claim 20**, Hendricks and/or Ellis does not disclose: “a selection means for allowing an end user to select between information from the signal reflective of the regular program and information from the second BC signal for inclusion in the video output signal,” as required by Claim 20. The remote device in Hendricks and/or Ellis has nothing to do with selecting a BC signal, as claimed because as discussed advertisements in Hendricks and/or Ellis have nothing to do with displaying Background Commercials with regular programming as claimed. It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per **Claim 21**, Hendricks and/or Ellis does not disclose: “a User Interface means for obtaining User commands to enable or disable the inclusion of

Banner Information and/or the second BC signal in the video output signal and a control unit for providing control signals reflective of the User commands,” as required by Claim 21. Nor are there multiple BS signals disclosed by Hendricks and/or Ellis. It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per **Claim 22**, Hendricks and/or Ellis does not disclose: “a storage means for storing Background Commercial view data and a transmission means for providing a return signal reflective of the Background Commercial view data,” as required by Claim 22. It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per **Claim 23**, Hendricks and/or Ellis does not disclose: “a storage means for storing information from the second BC signal, and means for replaying the second BC signal stored in the storage means to the means for providing a video output signal for inclusion in the video output signal,” as required by Claim 23. It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per **Claim 24**, Hendricks and/or Ellis does not disclose: “a storage means for storing information from the second BC signal and means for replaying the second BC signal stored in the storage means to the means for providing a video output signal for inclusion in the video output signal, wherein there is information reflective of a

plurality of Background Commercials within the digital signal, the second BC signal stored in the storage means is related to the plurality of the Background Commercials, and the means for replaying provides one or several of the stored plurality of Background Commercials for inclusion in the video output,” as required by Claim 24. It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per **Claim 25**, Hendricks and/or Ellis does not disclose: “a storage means for storing information from the signal reflective of the regular program, and means for replaying the signal reflective of the regular program stored in the storage means to the means for providing a video output signal for inclusion in the video output signal,” as required by Claim 25. It is respectfully submitted that the Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Claims 26-33 are allowable for at least the reasons provided hereinabove. If any of the claims in the application are rejected, Applicant reserves the right to provide further arguments/evidence in support of allowability of such claims.

CONCLUSION

For these, and other, reasons, Applicants believe that the claims are in condition for allowance. Reconsideration, re-examination, and allowance of all claims are respectfully requested.

<p align="center"><u>CERTIFICATE OF MAILING</u></p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February <u>20</u>, 2007.</p> <p>By Sarah A. Nielsen</p> <p><u>Sarah A. Nielsen</u> Signature</p>

Respectfully submitted,

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